

### **Remarks/Arguments**

In response to the Office Action dated April 13, 2006, claims 1-4, 6 and 9 have been amended to more clearly set forth the patentable subject matter without acquiescing in the Examiner's reasons for rejections. Accordingly, claims 1-9 are pending and are submitted for examination.

#### **I. Claim Objection**

The Examiner objected to claims 1-4, 6 and 9 because of the informality of not reciting the entire phrase of "the outdoor billboard" and, instead, reciting simply "the billboard" after the antecedent basis has been established. Applicant respectfully disagrees as "the billboard" clearly refers back to the introduction of the term "an outdoor billboard" (i.e., there is no other "billboard" introduced in any of the claims). However, Applicant amended the claims as suggested by the Examiner simply to expedite the prosecution of the present invention.

The Examiner also pointed out that the phrase "may have seen" in claim 4 should have been amended to "saw" in order to be consistent with other claims. Claim 4 has been so amended.

#### **II. Double Patenting**

The Examiner rejected claims 1 and 6 on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 5 of U.S. Patent No. 6,823,332 (the '332 Patent).

Applicant respectfully disagrees. The present application is a divisional of the '332 Patent. As such, it has already been decided by the U.S. Patent Office that the present invention is patentably different from the '332 Patent.

Accordingly, Applicant requests that the Examiner withdraws the double-patenting rejection.

### **III. Rejections Based on 35 USC § 112**

The Examiner alleges that the recitation of "a web site" in claim 6 is indefinite and suggests that it be changed to "at least one web site." Applicant has so amended the claim without acquiescing in the Examiner's reasons for rejection.

### **IV. Rejections Based on 35 USC § 102 and § 103**

The Examiner rejected claims 1-3 as allegedly being anticipated by USP 5,926,116 ("Kitano"). In addition, the Examiner rejected claims 4-9 as allegedly being unpatentable over Kitano in view of USP 5,926,116 ("Bandera") and USP 6,269,361 ("Davis"). Applicant respectfully disagrees.

The Examiner rests the bulk of his reasons for rejection upon the teachings of Kitano. Applicant submits that while they present a somewhat similar method as the present invention, Kitano's teachings are patentably different.

More specifically, Kitano teaches the use of (1) a digital camera in combination with (2) a global positioning system ("GPS") and (3) a portable computer terminal in order to search for a website that is associated with an outdoor advertisement that does not include a website address. Having the user carry all three items listed above, Kitano teaches the user to take a photograph of an advertisement in question, use the GPS to pinpoint the latitude and longitude of the user's position, and transmit the photographed

image and GPS position to a database to search for a registered website having those identifiers. Furthermore, the database uses 1 criterion and 1 criterion only in rendering the search results: by comparing the photographed image with the image(s) in the database. No other identifiers mattered when the Kitano database performs its search.

This is patentably different from the teachings of the present invention. None of the three items essential to the Kitano method and system is needed for the instant invention. More importantly, the present claims expressly recite “a web site address advertised on an outdoor billboard.” Kitano teaches away from this limitation because the user is in constant contact with the computer database and receives the results of the search almost instantaneously via the portable terminal. If the web site address were on the billboard, a Kitano user would have no reason to perform the search. He would simply write it down – the Kitano user receives the search result from the database as he is looking at the advertisement. Similarly, Kitano’s setup makes the word “saw” in the present claims inaccurate. A Kitano user did not see the advertisement, but rather she is “seeing” the advertisement as the search is performed.

The present invention is directed to users who have seen the website directly on a billboard but cannot recall the website at a later time after leaving the location of the billboard.

Therefore, as a threshold matter, Kitano not only does not anticipate the present invention, but it cannot be properly combined with other references to render the present invention obvious.

Moreover, Applicant has removed the recitation of “the name of a city” as one of the identifiers in claim 4. This further eliminates the Examiner’s use of Bandera.

Accordingly, it is respectfully submitted that the Examiner’s rejections have been properly overcome, and that the application is fully in condition for allowance. A notice to that effect is earnestly solicited.

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Reply to Office Action of April 13, 2006

The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview may be useful for any reason.

Respectfully submitted,

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